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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,349	10/21/2003	Jose B. Rivera	BCI-168US	4160

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/690,349

Applicant(s)

RIVERA ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's remarks, filed January 8, 2007, are noted and appreciated.
2. Claims 1-30 remain pending. No claims were amended.

Election/Restrictions

3. Claims 1-16 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2006.

Response to Arguments

4. Applicant's arguments filed January 8, 2007, have been fully considered but they are not persuasive.
 - A. The Examiner notes, upon further review of the claims, that claim 25, not claim 27, should have been rejected under 35 USC 103(a) as obvious over Rivera in view of Petrole. While this would have been readily apparent to Applicant insofar as claim 25 recites an aluminum substrate and Petrole is cited solely to demonstrate that an aluminum substrate would have been obvious to one of ordinary skill in the art, the Examiner apologizes for any confusion and/or inconvenience. The claims are grouped properly below.
 - B. Applicant argues that there would have been no expectation of success in combining the two treatments of Rivera and that Applicant demonstrates an additive result when a diminished result would have been expected. The Examiner disagrees.

i. Contrary to Applicant's assertion, there is absolutely no evidence that a combination of treatments would have led to undesirable performance. The "failure" rating given by Rivera to Example 3 is described as "surprising" and "anomalous" [7:16-22]:

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TABLE 1

Rating	Example 1	Example 2	Example 3	Example 4	
Overall	Pass	Pass	Fail	Fail	5
Scribe	0.5 mm failure @ 1000 hrs.	0 mm failure @ 1000 hrs.	5 mm failure @ 750 hrs.	5 mm failure @ 1000 hrs.	
Field	1% failure @ 1000 hrs.	1% failure @ 1000 hrs.	3% failure @ 1000 hrs.	1 failure @ 500 hrs.	10

The overall rating of pass or fail is determined if there are more than three millimeters from the scribe. Also, in order to pass, there must be no corrosion spots, blistering, chipping, peeling, or gloss or adhesion loss.

As can be seen, the preferred embodiment of the present invention appears to be the use of a silane-based bath, which performed superior to the use of a polymeric blend of PVA and PAA (Example 3). The failure of Example 3 and the poor performance in the scribe test, particularly when compared with Example 4, is somewhat surprising and believed to be somewhat anomalous.

Both Examples 1 and 2, as can be seen from Table 1, performed quite well in the scribe test and each only had 1% failure at 1000 hours in the field test.

Such a characterization is far from a conclusive indication disparaging the performance of Example 3.

ii. Applicant is reminded that references are part of the literature of the art, relevant for all they contain, and that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.¹ Further, Applicant is reminded that the expectation of success need only be reasonable, not absolute, and that the knowledge that

¹ MPEP 2123

an element would work for its intended purpose tends to show reasonable expectation of success using that element.² Since Rivera broadly discloses a composition containing a group IV-B element and a polymer blend as effective, this “anomalous” result for a specific composition does not conclusively demonstrate that any and all such compositions, elsewhere taught as effective, are ineffective.

iii. Finally, Applicant is reminded that “[e]vidence showing there was no reasonable expectation of success may support a conclusion of non-obviousness.”³ While Applicant has pointed out an anomalous, ineffective result for one specific composition, this observation is not evidence establishing that the combination of Rivera’s organo-functional silane, group IV-B element, and polymer blend having –OH and –COOH functionalities would, necessarily, yield an ineffective result.

C. Applicant argues, with respect to claims 18-20, that the ratio of silane to polymer blend is not a result-effective variable. The Examiner disagrees. What amount of polymer to add to a coating composition is the most basic question faced by the artisan. If the artisan cannot answer this question he or she cannot proceed. That the limitations of these claims occupy such a fundamental level of inquiry is evidence enough of their recognition of result-effective variables.

D. With respect to the Petrole reference, the Examiner acknowledges that this reference does not teach Applicant’s claimed composition. The Examiner has not

² *Pfizer, Inc. v. Apotex, Inc.*, CAFC (2006-1261)

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relied upon this reference to do so. Rather, it demonstrates that coatings containing similar components to those of Rivera may successfully be applied to aluminum substrates and, thus, renders the application of the compositions of Rivera to aluminum substrates obvious.

E. With respect to the double-patenting rejections, it is the Examiner's position that application of the solutions separately is recited in Rivera's claims (specifically claims 1, 9, and 11). The Examiner does not rely on the body of Rivera at all. Nevertheless, Applicant is reminded that reference to the disclosure is, in fact, permissible. The section of MPEP cited at page 8 of the response continues:

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). This does not mean that one is precluded from all use of the patent disclosure.

Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out that "this use of the disclosure is not in contravention

³ MPEP 2143.02

of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.”

Even if Rivera's claims did not recite the compositional components, it would still be proper to refer to Rivera's reference as the basis for selecting the compositions taught as operative. The basis for holding the combination obvious is the same as that determined by the courts, which clearly and unambiguously explains the presence of the “prior art” language. Finally, the Applicant's contention that the use of Petrole as a secondary reference in an obviousness-type double patenting rejection is contrary to US Patent Law and USPTO practice and procedure which states: “[T]he analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 USC 103(a) rejection.”⁴

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

⁴ MPEP 804

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 17-24 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al. (US 6,126,997 A).

A. These claims are rejected for the same reasons as set-forth under this heading in the prior Office action.

B. These claims remain obvious over the cited prior art for the reasons explained above.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., as applied to claim 17 above, and further in view of Petrole et al. (US 5,700,523 A).

A. This claim is rejected for the same reasons as set-forth under this heading in the prior Office action.

B. This claim remains obvious over the cited prior art for the reasons explained above.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 17-24 and 26-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-15 of U.S. Patent No. 6,126,997 A.

A. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set-forth under this heading in the prior Office action.

B. These claims remain rejected for the reasons explained above.

11. Claim 25 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 6,126,997 A in view of Petrole et al. (US 5,700,523 A).

A. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons set-forth under this heading in the prior Office action.

B. This claim remains rejected for the reasons explained above.

Conclusion

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

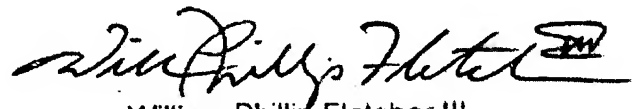
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III
Primary Examiner
Art Unit 1762

March 31, 2007